

REMARKS

The above-identified application has been reviewed in light of the Office Action mailed June 8, 2011. No amendments to the claims are being submitted herewith. Claims 1-24, 26 and 30 had previously been cancelled, so claims 25 and 27-29 are currently pending and under consideration. Applicant submits that the claims pending in this application are allowable over the cited references of record. Reconsideration and allowance of the present application is respectfully requested.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 25 and 27-29 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0090339 to Whalen et al. (hereinafter “Whalen”) in view of U.S. Patent Application Publication No. 2004/0224864 to Patterson et al. (hereinafter “Patterson”), or U.S. Patent Application Publication No. 2004/0197302 to Porter et al. (hereinafter “Porter”). The rejections were maintained for reasons of record in the previous office actions filed on July 20, 2009 and December 24, 2009, April 9, 2010, and October 22, 2010. Applicant respectfully disagrees because an obviousness rejection under 35 U.S.C. § 103 requires a suggestion of *all limitations* in a claim, In re Wanda and Murphy, Appeal 2007-3733 (B.P.A.I. Jan. 2008), and the references fail to disclose, teach or suggest several limitations.

More specifically, while Whalen teaches embolic compositions including a biocompatible polymer, a biocompatible contrast agent, and a biocompatible solvent, nowhere does Whalen

teach or suggest a composition consisting of up to 40 weight percent of ethylene vinyl alcohol copolymer; dimethylsulfoxide; and from 45 to no more than 60 weight percent of tantalum contrast agent having an average particle size of about 5 microns or less, wherein the ratio of ethylene vinyl alcohol copolymer to the tantalum contrast agent is from 0.077 to 0.90 and the weight percent of each component is based on the total weight of the composition, and further wherein said composition has a viscosity of 150 cSt or higher at 40°C, as recited in claim 25. Whalen does not teach the use of a contrast agent in an amount from 45 to no more than 60 weight percent in the composition.

Neither Patterson nor Porter remedy the deficiencies of Whalen, no matter how these references may be combined. While Patterson discloses a composition of a biocompatible polymer, a contrast agent, and fumed silica (a rheology modifier), nowhere does Patterson teach or suggest a composition consisting of up to 40 weight percent of ethylene vinyl alcohol copolymer; dimethylsulfoxide; and from 45 to no more than 60 weight percent of tantalum contrast agent having an average particle size of about 5 microns or less, wherein the ratio of ethylene vinyl alcohol copolymer to the tantalum contrast agent is from 0.077 to 0.90 and the weight percent of each component is based on the total weight of the composition, and further wherein said composition has a viscosity of 150 cSt or higher at 40°C, as recited in claim 25.

Similarly, while Porter teaches a rheologically-modified composition comprising a solution including a biocompatible prepolymer, a contrast agent, and a rheological modifier, nowhere does Porter teach or suggest a composition consisting of up to 40 weight percent of

ethylene vinyl alcohol copolymer; dimethylsulfoxide; and from 45 to no more than 60 weight percent of tantalum contrast agent having an average particle size of about 5 microns or less, wherein the ratio of ethylene vinyl alcohol copolymer to the tantalum contrast agent is from 0.077 to 0.90 and the weight percent of each component is based on the total weight of the composition, and further wherein said composition has a viscosity of 150 cSt or higher at 40°C, as recited in claim 25.

As is apparent, the only references that teach greater than 40 weight percent of water-insoluble contrast agent (Porter and Patterson) further employ a rheology modifier. Thus, it is respectfully submitted that both Porter and Patterson, which teach the need for employing rheology modifiers in their compositions to obtain a proper viscosity, teach away from the recited composition.

Accordingly, for at least the foregoing reasons, it is respectfully submitted that claim 25 is patentable over Whalen in view of Patterson and/or Porter, no matter how these references may be combined. Claims 27-29 depend from claim 25 and incorporate all of its limitations therein. Thus, for at least the reasons listed above with respect to claim 25, claims 27-29 are similarly patentable over Whalen in view of Patterson and/or Porter. Accordingly, withdrawal of the rejection of claims 25 and 27-29 under 35 U.S.C. §103(a) is respectfully requested.

Nonstatutory Obviousness Type Double Patenting

Claims 25-30 were rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,667,767 and claims 1-8 and 16-23 of U.S. Patent No. 5,695,480. (Claims 25 and 27-29 are pending at this time.)

Applicants maintain that none of the cited references teach or suggest a contrast agent concentration of from 45 to no more than 60 weight percent. At best, the prior art teaches a maximum of about 40 weight percent tantalum. Furthermore, the art teaches that preferred embodiments use less than 40 weight percent tantalum. Such would teach away from the currently claimed range found in now presented Claim 25.

However, in the interest of advancing prosecution of the instant application, Applicants will consider filing a terminal disclaimer as to these references once all other issues of patentability are resolved.

Conclusion

Applicants submit that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. Should the Examiner believe that a telephone interview may facilitate resolution of any outstanding issues, the Examiner is respectfully requested to telephone Applicant's undersigned attorney at the number listed below.

In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In consideration of the foregoing discussion, the subject application is believed to be in condition for allowance. Early allowance of the subject application is respectfully solicited.

Respectfully submitted,



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